

Application No.: 09/937587

Case No.: 54676US002

### Remarks

#### Rejections under 35 U.S.C. 102 and 103

Claims 1-3 and 5-19 are stand rejected under 35 U.S.C. 102 (b) as being anticipated by Orensteen et al., U.S. Patent No. 5,508,105 for the reasons previously of record (paper #6, mailed May 6, 2003).

Further Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Orensteen et al. (5,508,105) in view of Frank et al. (5,153,618).

For both of these rejections, the Examiner relies on Orensteen et al. as allegedly teaching a radiation cured coating.

Accordingly to the MPEP 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second there must be reasonable expectation of success. **Finally, the prior art references must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Applicant previously argued that Orensteen fails to teach a **radiation cured coating**.

In response to Applicant's arguments, the Examiner stated that "Example 1 discloses that the different polyurethane compositions may have crosslinkers (col. 16, line 41). Example 1 further discloses that the coating is cured at room temperature followed by heating (col. 17, lines 16-17). Heat is a type of radiation, thus the composition is a radiation cured composition."

The Applicant would like to bring to the attention of the Examiner that p. 15, lines 11-20 of Applicant's patent application states:

*More preferred precursors are those that are curable using radiation. These are referred to herein as radiation curable materials. As used herein, "radiation cure" or "radiation curable" refers to curing mechanisms that involve polymerization and/or crosslinking of resin systems upon exposure to ultraviolet radiation, visible radiation, electron beam radiation, or combinations thereof, optionally with the appropriate catalyst or initiator. Typically, there are two types of radiation cure mechanisms that occur -- free radical curing and cationic curing.*

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*These usually involve one stage curing or one type of curing mechanism. Mixtures of free radical and cationic materials may also be cured to impart desired properties from both systems. Also possible are dual-cure and hybrid-cure systems, as discussed below.*

The Examiner's position that heat is also a type of radiation cure is contrary to the definition set for the in Applicant's patent application.

Accordingly, withdrawal of the rejections and a timely allowance are respectfully requested.

Respectfully submitted,

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Date

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